IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/693,672	§	Examiner: Patel, Haresh N.
October 19, 2000	§	Group/Art Unit: 2154
Inventors:	§	Atty. Dkt. No: 5181-72200
Mohamed M. Slaughter, et al.	§	

Title: Bridging between a Data §
Representation Language §
Message-Based Distributed §
Computing Environment §
and Other Environments §
§

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants request review of the rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reasons stated below.

Claims 1-24, 51-73, 100-117, 136 and 138 are pending in the application. Reconsideration of the present case is earnestly requested in light of the following remarks. For brevity, only the primary arguments directed to the independent claims are presented, and that additional arguments, e.g., directed to the subject matter of the dependent claims, will be presented if and when the case proceeds to Appeal.

The Examiner rejected claims 1-24, 51-73, 100-117, 136 and 138 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6,868,447. The Examiner rejected claim 138 under 35 U.S.C. § 102(e) as being anticipated by Tuatini. The Examiner also rejected claims 1-5, 19-21, 23, 24, 51-55, 68-70, 72, 73, 100-103, 113, 114, 116 and 117 under 35 U.S.C. § 103(a) as being unpatentable over Tuatini in view of Mead et al. (U.S. Patent 6,061,728) (hereinafter "Mead"), and claim 136 as being unpatentable over Tuatini in view of Cheng (U.S. Publication 2001/0032273), Machin et al. (U.S. Publication 2002/0032806) (hereinafter "Machin") and Beck et al. (U.S. Patent 6,604,140) (hereinafter "Beck"). Applicants traverse these rejections for the following reasons.

Regarding claim 138, the rejection of claim 138 is improper (among other reasons) because the Examiner has not shown that Tuatini qualifies as a prior art reference. The Examiner has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). The Tuatini patent was filed on January 2, 2001, <u>after</u> applicants' filing date of October 19, 2000. Tuatini does claim the benefit of provisional applications filed December 30, 1999. However,

the December 30, 1999 filing date can only be used as Tuatini's 35 U.S.C. § 102(e) prior art date for the subject matter that is common to both the Tuatini patent and the provisional applications. Since it is common practice for a later filed utility application to include more or different subject matter than its earlier provisional application(s), it is unclear whether the material in Tuatini relied upon by the Examiner was actually present in Tuatini's provisional applications. In fact, from even a cursory review it is clear that Tuatini's published application differs greatly from its provisional applications.

Moreover, the Tuatini publication is not entitled to the December 30, 1999 date as a section 102(e) prior art date unless at least one claim of the Tuatini publication is supported (under 35 U.S.C. § 112) in the provisional application. Under 35 U.S.C. 119(e)(1), a published patent application is not entitled to its provisional application's filing date as a prior art date unless at least one claim of the published application is supported (per 35 U.S.C. § 112) in the provisional application. The rejection is improper unless the Examiner can show that Tuatini's published application has the necessary claim support in the provisional application to be entitled to the provisional application's filing date as its § 102(e) prior art date. *See also* M.P.E.P. § 2136.03(IV).

In response to Applicants' previous request that the Examiner particularly point out those portions of Tuatini's provisional application relied upon by the Examiner, as required by 37 CFR 1.104(c)(2), the Examiner refers to pages 4, 16, 78, 112, 236, 324, and 428 of Tuatini's provisional application 60/173,712. **However, as with the other pages cited by the Examiner from the 60/173,712 provisional application, none of these pages support the subject matter relied upon by the Examiner in the rejection of claim 138.** Please refer to Applicants' previous response for a detailed description of why the pages cited by the Examiner do not support the subject matter relied upon by the Examiner (Response to Final Action, dated March 8, 2006, pages 27-29).

Furthermore, the pages of the Tuatini provisional application cited by the Examiner do not support any of the claims of Tuatini's application. For instance, the pages cited by the Examiner do not support claim 1 of the Tuatini application per the requirements of 35 U.S.C. § 112, first paragraph. The Examiner has not met his burden of proof to show that Tuatini qualifies as prior art.

In further regard to claim 138, Tuatini does not disclose <u>the proxy service</u> providing to the first entity an interface to a second entity in the second computing environment, wherein providing an interface comprises <u>sending to the first entity a schema defining one or more messages</u> in the data representation language for accessing the second entity, in contrast to the Examiner's contention. The Examiner cites paragraphs [0166-0168] where Tuatini describes the use of an LDAP directory service. However, Tuatini does not teach sending a client application (which the Examiner equates to a first entity) a schema defining one or more messages in the data representation language for accessing the second entity. Instead, Tuatini describes how a LDAP directory may include a schema defining object classes of information that can be stored in the directory entries. Tuatini does not mention anything about a schema defining messages in a data representation language for accessing the LDAP directory service. Tuatini also fails to mention sending such a schema to the client application. Furthermore, Tuatini teaches how a client accesses a LDAP directory by instantiating a directory manager object and uses methods of the directory manager object to retrieve other objects (both directory entry objects and adapter objects) for accessing particular directory entries. (Tuatini, paragraph [0167]). Thus, Tuatini's system provides access objects for the entries of a LDAP directory service rather than sending a schema defining messages in a data representation language for accessing the directory service.

The Examiner also cites paragraphs [0122-0132] where Tuatini describes the use of a XML document type definition (DTD) to specify message parameters used to request service functions. However, the cited passage does not mention a proxy service sending the XML DTD to a client component, which is required by Applicants' claim 138. Instead, Tuatini describes that the XML DTD may be a part of a group of information for each shared service providing functionality to clients and that the information is "made available to others" (Tuatini, paragraph [0125]). The mere statement that an XML DTD is *made available* to others does not disclose the specific limitation of *a proxy service sending* a schema to a first entity, as recite in applicants' claim 138.

There are, in fact, many ways in which information may be "made available" to entities in a distributed computing environment, as is well known in the art. For example, Tuatini states that the XML DTDs may be stored separately from the access interface information (Tuatini, paragraph [0128]) and that Tuatini's messaging component may *retrieve* the XML DTD to verify that a message is properly formatted, thus implying that in Tuatini's system the XML DTDs are made available by storing them in a shared location.

Regarding claims 1, 51, 100, and 136, the Examiner's rejection is improper because, as shown above, Tuatini has not been established to be prior art to the present application.

In further regard to claim 1, **Tuatini in view of Mead fails to teach or suggest a proxy service providing to the first entity an interface to a second entity in the second computing environment, wherein the proxy service appears to the first entity as the second entity.** The Examiner relies upon Mead, citing column 3, lines 1 through column 4, line 24. Mead teaches a system in which multiple proxy devices coordinate to communicate messages between local area networks via a wide area network using a transparent bridging system. Specifically, Mead teaches the use of a master proxy device that mediates and selects which of the proxy devices should handle which messages sent between a local area network and a wide area network.

The Examiner's assertion that Mead teaches the use of a proxy service that appears to a first entity as a second entity is clearly erroneous. Nowhere does Mead mention that his proxy devices appear as other entities to components of Mead's system. Instead, Mead's proxy devices route messages received from an end station between two local area networks via a wide area network. The Examiner is apparently relying upon the fact that Mead's system includes a transparent bridging mechanism. However, transparent bridging is well understood in the art and **does not include** a proxy service that provides an interface to a second entity **and that** *appears as the second entity to a first entity*. Mead's proxy devices are transparent because an entity on one local area network sending a message to another local area network via a wide area network is not aware that the proxy devices are performing the routing. Mead's proxy devices route network message frames from one network to another. The end stations in Mead's system are not aware of Mead's proxy devices at all and do not view the proxy devices as some other entity in the computing environment. The Examiner has never provided any interpretation that shows how Mead's proxy devices, which as admitted by the Examiner provide a *transparent* bridging service, can appear as a second entity to a first entity.

In response to Applicants' argument the Examiner, as well as repeating previous citations, refers to a computer dictionary definition of various terms, such as proxy, bridge, schema, etc. However, none of the definitions in the cited reference describe or mention anything about a proxy service that appears as a second entity to a first entity and thus fail to support the Examiner's rejection.

Additionally, the Examiner's proposed combination of Tuatini and Mead would not result in a system that includes a proxy service providing to a first entity an interface to a second entity where the proxy service appears to the first entity as the second entity. Instead, the Examiner's proposed combination of Tuatini and Mead would result only in allowing Tuatini's application framework, including the messaging component to also transparently route messages between local area networks via a wide area networks using the multiple proxy devices of Mead. Since neither Tuatini nor Mead, whether considered single or in combination, teaches or suggests a proxy service that appears as another entity, no combination of Tuatini and Mead would include such a proxy service (that appears as another entity).

Moreover, Mead's proxy devices are at a completely different computing layer than Tuatini's messaging component, which the Examiner interprets as the proxy service of Applicants' claim. Tuatini's messaging component does not have anything to do with routing frames between a LAN and a WAN. Even if one where to modify the messaging component of Tuatini, the result would merely allow Tuatini's messaging component to route messages between a local area network and a wide area network and between an Ethernet protocol and a

TCP/IP protocol, as taught by Mead's proxy devices. Nothing in such a combination would include or suggest that the messaging component would appear as another entity.

Regarding claim 136, Tuatini in view of Cheng, Machin and Beck fails to teach or suggest <u>a proxy service providing</u> to the first entity an interface to a second entity in the second computing environment comprises providing <u>an advertisement for the second entity</u>, wherein the advertisement for the second entity <u>includes access information for accessing the second entity</u> in the second environment from the first environment and wherein the advertisement <u>includes information describing one or more computer programming language method calls</u> to methods in the computer programming language provided by the second entity. The Examiner cites FIG. 3 and paragraphs 9-12 and 23-24 of Cheng. However, the cited portions of Cheng do not describe providing an advertisement including access information and information describing computer programming method calls. Instead, Cheng teaches the use of thin glue layers to bridge a non-IP network with the Internet. Cheng's thin glue layers translate between the IP protocol and the non-IP protocol and allow commands and responses to tunnel between applications in the Internet and the non-IP network (Cheng, paragraph [0011]).

The Examiner seems to be arguing that Cheng's teachings regarding a HAVi (a particular non-IP network) application using a HAVi API to access Internet services implies providing an advertisement including access information and describing method calls. However, Cheng does not mention providing any sort of *advertisement that includes access information or describing computer programming language method calls.* Instead, Cheng only refers to the fact that the glue layers can translate between the two protocols. The Examiner admits that Tuatini fails to provide an advertisement including access information and describing computer programming language method calls. Thus, the Examiner proposed combination of Tuatini and Cheng also fails to teach providing an advertisement including access information and describing computer programming language method calls. Furthermore, Machin and Beck fail to overcome the above noted deficiencies of both Tuatini and Cheng. Therefore, the combination of Tuatini, Cheng, Machin and Beck fails to teach or suggest a proxy service providing an advertisement including access information and describing method calls.

Thus, for at least the reasons above, the rejection of claim 136 is not supported by the prior art and removal thereof is respectfully requested.

The Examiner's rejection of many of the dependent claims is additionally erroneous. For example, the cited art is clearly insufficient to support the rejection of claims 22, 71 and 115 as discussed in detail in Appellants' previous response on pp. 32-34.

Regarding the obviousness-type double patenting rejection, the Examiner has failed to state a proper obviousness-type double patenting rejection. Simply noting a few similarities between the claims does not satisfy the Examiner's burden to state valid reasons (supported by evidence of record) why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim of the other patent/application. Nor has the Examiner specifically addressed **each difference** of the claim of the present application compared to the claim of the other application. Instead, the Examiner merely states, "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the patent teaches the limitations as disclosed such that the interpretation of a first entity accessing a second entity through messages in a data representation language is equivalent to a first client sending a first message in to a first service and the first service generating a set of results in response to the first message, wherein the set of results are expressed in a data representation language and using a space, advertisement, XML, and URI." The Examiner clearly has not met the requirements (as stated in MPEP 804.II.B.1) to establish a *prima facie* obviousness-type double patenting rejection. Accordingly, Applicants respectfully request removal of the double patenting rejection.

Additionally, the Examiner notes the claims of U.S. Patent No. 6,868,447 do not include the limitations in
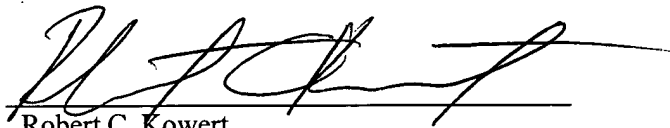
regard to bridging and proxy service as recited in the claims of the present application. The Examiner contends that these limitations were well known and would be obvious and refers to the Tuatini reference for support. Applicants traverse the Examiner's assertion that these limitations were well known *in the context of Applicants' claimed invention*. Additionally, the Examiner's reliance on Tuatini for the double patenting rejection (and the § 102 and § 103 rejections discussion above) is misplaced as 1) Tuatini fails to teach or suggest the particular limitations of Applicants' claims (as discussed above regarding individual claim rejections) and 2) the Examiner has not properly shown that Tuatini qualifies as prior art. As to the several other references cited by the Examiner, these references may indicate that bridging and proxy services were well known *in other contexts*, but fail to show that bridging and proxy services were well known in the context of the particular limitations of Applicants' claimed invention. For at least the reasons above, Applicants respectfully request removal of the double patenting rejection.

In light of the foregoing remarks, Appellants submit the application is in condition for allowance, and notice to that effect is respectfully requested. If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Appellants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 501505/5181-72200/RCK.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard
☒ Notice of Appeal

Respectfully submitted,

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